

The opinion in support of the decision being entered today was not written for publication and is not binding precedent of the Board.

Paper No. 20

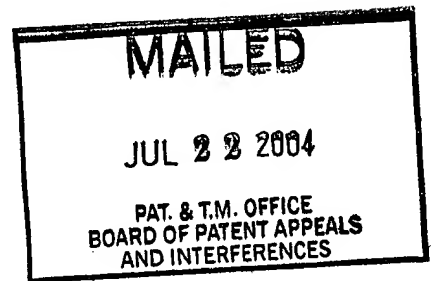
UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte RICHARD C. GOSSWEILER III, KENNETH P. FISHKIN,
BEVERLY L. HARRISON, ANUJ UDAY GUJAR and ROY WANT

Appeal No. 2003-0956
Application No. 09/391,462

ON BRIEF



Before FLEMING, RUGGIERO, and MACDONALD, **Administrative Patent Judges.**

MACDONALD, **Administrative Patent Judge.**

DECISION ON APPEAL

This is a decision on appeal from the final rejection of claims 1-8. Appellants have withdrawn the appeal of claim 9 and the claim is not before us. (Appellants' brief, page 7)

Invention

Appellants' invention relates to the navigation of a digital environment representative of data sets by using multiple physical identifier tags. The sequential or combinatorial presentation of the multiple tags controls the navigation.

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(Appellants' specification, page 1, lines 3-7). The identifier tags are electronic tags each having a digitally or optically readable identifier. (Specification, page 2, lines 4-5). A tag reader scans a tag, the identifier is read from the tag, and a computer controls a digital service in the digital environment based on the identifier. (Specification, page 7, lines 22-25, and page 12, lines 21-22).

Claim 1 is representative of the claimed invention and is reproduced as follows:

1. A system for N-space navigation of digital data sets, the system comprising

an electronic tag having a digitally readable identifier

an electronic tag reader configured to read the identifier of the electronic tag,

a computing system connected to the electronic tag reader to provide digital navigation services of N-space data sets in response to reading the identifier of the electronic tag, with the computing system generating at least one transitional data point in N-space for output between a currently displayed start point and a target point referenced by the identifier.

References

The references relied on by the Examiner are as follows:

Card et al. (Card)	5,847,709	Dec. 8, 1998 (filed Sep. 26, 1996)
Pulley, IV et al. (Pulley)	6,222,557	Apr. 24, 2001 (filed Jun. 26, 1998)
Beigel et al. (Beigel)	6,249,212	Jun. 19, 2001 (filed Oct. 5, 1994)
Want et al. (Want)	6,342,830	Jan. 29, 2002 (filed Sep. 10, 1998)

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Rejections At Issue

Claims 1, 2, and 4-8 stand rejected under 35 U.S.C. § 103 as being obvious over the combination of Want and Pulley.

Claims 1 and 3-8 stand rejected under 35 U.S.C. § 103 as being obvious over the combination of Beigel and Card.

Throughout our opinion, we make references to the Appellants' briefs, and to the Examiner's Answer for the respective details thereof.¹

OPINION

With full consideration being given to the subject matter on appeal, the Examiner's rejections and the arguments of the Appellants and the Examiner, for the reasons stated *infra*, we affirm the Examiner's rejection of claims 1, 2, and 4-8 under 35 U.S.C. § 103, and we reverse the Examiner's rejection of claim 3 under 35 U.S.C. § 103.

Appellants have indicated that for purposes of this appeal, the claims stand or fall together in five groupings:

Claims 1, 4, and 6-8, as Group I;

Claim 2 as Group II;

¹Appellants filed an appeal brief on October 21, 2002.
Appellants filed a reply brief on February 3, 2003. The Examiner mailed out an Examiner's Answer on November 29, 2002.

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Claim 3 as Group III; and

Claim 5 as Group IV.

See pages 6-7 of the brief. Furthermore, Appellants argue each group of claims separately and explain why the claims of each group are believed to be separately patentable. See pages 7-20 of the brief and pages 2-3 of the reply brief. Appellants have not fully met the requirements of 37 CFR § 1.192 (c)(7) (July 1, 2002) as amended at 62 Fed. Reg. 53169 (October 10, 1997), which controlled at the time of the filing of Appellants' brief.

37 CFR § 1.192 (c)(7) states:

Grouping of claims. For each ground of rejection which appellant contests and which applies to a group of two or more claims, the Board shall select a single claim from the group and shall decide the appeal as to the ground of rejection on the basis of that claim alone unless a statement is included that the claims of the group do not stand or fall together and, in the argument under paragraph (c)(8) of this section, appellant explains why the claims of the group are believed to be separately patentable. Merely pointing out differences in what the claims cover is not an argument as to why the claims are separately patentable.

Because Appellants have not separated the groups by grounds of rejection, we will. Therefore, we consider Appellants' claims as standing or falling together in the groups as follows:

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Group I: Claims 1, 4, and 6-8, as rejected over the combination of Want and Pulley;

Group II: Claims 1, 4, and 6-8, as rejected over the combination of Beigel and Card;

Group III: Claim 2;

Group IV: Claim 3;

Group V: Claim 5, as rejected over the combination of Want and Pulley; and

Group VI: Claim 5, as rejected over the combination of Beigel and Card;

We will treat:

Claim 1 as a representative claim of Groups I and II;

Claim 2 as a representative claim of Group III;

Claim 3 as a representative claim of Group IV; and

Claim 5 as a representative claim of Groups V and VI.

"If the brief fails to meet either requirement, the Board is free to select a single claim from each group and to decide the appeal of that rejection based solely on the selected representative claim." ***In re McDaniel***, 293 F.3d 1379, 1383, 63 USPQ2d 1462, 1465 (Fed. Cir. 2002). See also ***In re Watts***, 354 F.3d 1362, 1368, 69 USPQ2d 1453, 1458 (Fed. Cir. 2004).

**I. Whether the Rejection of Claims 1, 4, and 6-8 Under
35 U.S.C. § 103 as Being Obvious over Want and Pulley is
proper?**

It is our view, after consideration of the record before us, that the evidence relied upon and the level of skill in the particular art would have suggested to one of ordinary skill in the art the obviousness of the invention as set forth in claims 1, 4, and 6-8. Accordingly, we affirm.

In rejecting claims under 35 U.S.C. § 103, the Examiner bears the initial burden of establishing a **prima facie** case of obviousness. **In re Oetiker**, 977 F.2d 1443, 1445, 24 USPQ2d 1443, 1444 (Fed. Cir. 1992). **See also In re Piasecki**, 745 F.2d 1468, 1472, 223 USPQ 785, 788 (Fed. Cir. 1984). The Examiner can satisfy this burden by showing that some objective teaching in the prior art or knowledge generally available to one of ordinary skill in the art suggests the claimed subject matter. **In re Fine**, 837 F.2d 1071, 1074, 5 USPQ2d 1596, 1598 (Fed. Cir. 1988). Only if this initial burden is met does the burden of coming forward with evidence or argument shift to the Appellants. **Oetiker**, 977 F.2d at 1445, 24 USPQ2d at 1444. **See also Piasecki**, 745 F.2d at 1472, 223 USPQ at 788.

An obviousness analysis commences with a review and consideration of all the pertinent evidence and arguments. "In

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reviewing the [E]xaminer's decision on appeal, the Board must necessarily weigh all of the evidence and argument." *Oetiker*, 977 F.2d at 1445, 24 USPQ2d at 1444. "[T]he Board must not only assure that the requisite findings are made, based on evidence of record, but must also explain the reasoning by which the findings are deemed to support the agency's conclusion." *In re Lee*, 277 F.3d 1338, 1344, 61 USPQ2d 1430, 1434 (Fed. Cir. 2002).

With respect to independent claim 1, Appellants argue, "[a]s in Lee [277 F.3d 1338], the Examiner of the application on Appeal has failed to establish that the references suggest the desirability of the invention disclosed in . . . claim 1." Appellants point out, "there are two scenarios by which one skilled in the art might be motivated to combine the disclosures of the '830 [Want] patent and '557 [Pulley] patent. The Examiner has not argued either of these. First, the Examiner has not shown that the '830 patent discloses or suggests in any manner navigation of any type of space." (brief, page 10). Appellants then argue, "[t]he combination of the two patents appears to be nothing more than hindsight reconstruction by the Examiner." Appellants also argue, "[t]he Examiner may also be of the position that the claimed invention in the present application would be obvious to try after reviewing the cited references. Obvious to try, however, is not the standard by which obviousness

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is determined under 35 U.S.C. § 103." (brief, page 11). We do not find Appellants' arguments persuasive.

With respect to the issue of "hindsight motivation," we find that no hindsight was needed to construct the combination of the Want and Pulley patents, as the motivation to combine was clearly present in the references. As Appellants noted themselves, one such motivation would be if the Want patent "discloses or suggests in any manner [, the] navigation of any type of space." Such is found at column 9, lines 30-33. Want states, "[t]here is an enumerated list of such actions - display a Web page, display a text document, display a date in a calendar, go to a certain location in a document, and so forth." We find that going to a certain location within a document is "navigation" within "a type of space." Therefore, Want provides a specific motivation to combine the Want and Pulley references.

In addition to this specific suggestion, we remind Appellants that the Examiner may find a motivation to combine prior art references in the nature of the problem to be solved. **Ruiz v. A.B. Chance Co.**, 357 F.3d 1270, 1276, 69 USPQ2d 1686, 1690 (Fed. Cir. 2004); **Also Pro-Mold & Tool Co. v. Great Lake Plastic Inc.**, 75 F.3d 1568, 1573, 37 USPQ2d 1626, 1630; **In re Huang**, 100 F.3d 135, 139 n.5; 40 USPQ2d 1685, 1688 n.5 (Fed. Cir. 1996). Want teaches that their system provides a

powerful tool for maintaining a bridge between the real and virtual worlds, and that the system allows the performance of user selected digital services. See Want at column 1, lines 54-61. Pulley at column 1, lines 19-20, teaches "various rendered 2D or 3D objects . . . can represent stocks, bonds, or other items of interest," and at lines 36-38, 45-46, and 59-60, "[I]t is typically desired by users . . . to view the landscape from more than one single fixed viewpoint and/or distance," "zooming . . . allows a user to: choose to observe a single object," and "the visualization system responds to input from the user to change the desired viewpoint accordingly." That is, Pulley is directed to solving the problem of providing a bridge between the real and virtual worlds and allowing the selection of digital services. We find that the nature of the problem to be solved also provides more than sufficient motivation to combine the prior art references.

We turn now to the issue of "obvious to try." Appellants are correct that "obvious to try" has long been held not to constitute the test for obviousness. However, equally it has long been held not to constitute the test for nonobviousness. ***In re O'Farrell***, 853 F.2d 894, 903-904 (Fed. Cir. 1988), discusses this point:

It is true that this court and its predecessors have repeatedly emphasized that 'obvious to try' is not the standard under § 103. However, the meaning of this maxim is sometimes lost. Any invention that would in fact have been obvious under § 103 would also have been, in a sense, obvious to try. The question is: when is an invention that was obvious to try nevertheless nonobvious?

The admonition that 'obvious to try' is not the standard under § 103 has been directed mainly at two kinds of error. In some cases, what would have been 'obvious to try' would have been to vary all parameters or try each of numerous possible choices until one possibly arrived at a successful result, where the prior art gave either no indication of which parameters were critical or no direction as to which of many possible choices is likely to be successful. *E.g., In re Geiger*, 815 F.2d at 688, 2 USPQ2d at 1278; *Novo Industri A/S v. Travenol Laboratories, Inc.*, 677 F.2d 1202, 1208, 215 USPQ 412, 417 (7th Cir. 1982); *In re Yates*, 663 F.2d 1054, 1057, 211 USPQ 1149, 1151 (CCPA 1981); *In re Antonie*, 559 F.2d at 621, 195 USPQ at 8-9. In others, what was 'obvious to try' was to explore a new technology or general approach that seemed to be a promising field of experimentation, where the prior art gave only general guidance as to the particular form of the claimed invention or how to achieve it. *In re Dow Chemical Co.*, 837 F.2d 469, 473, 5 USPQ2d 1529, 1532 (Fed. Cir. 1988); *Hybritech, Inc. v. Monoclonal Antibodies, Inc.*, 802 F.2d 1367, 1380, 231 USPQ 81, 90-91 (Fed. Cir. 1986), cert. denied, --- U.S. ---, 107 S.Ct. 1606, 94 L.Ed.2d 792 (1987); *In re Tomlinson*, 363 F.2d 928, 931, 150 USPQ 623, 626 (CCPA 1966). Neither of these situations applies here.

Obviousness does not require absolute predictability of success. Indeed, for many inventions that seem quite obvious, there is no absolute predictability of success until the invention is reduced to practice. There is always at least a possibility of unexpected results, that would then provide an objective basis for showing that the invention, although apparently obvious, was in law nonobvious. *In re Merck & Co.*, 800 F.2d at 1098,

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231 USPQ at 380; **Lindemann Maschinenfabrik GMBH v. American Hoist & Derrick Co.**, 730 F.2d 1452, 1461, 221 USPQ 481, 488 (Fed. Cir. 1984); **In re Papesch**, 315 F.2d 381, 386-87, 137 USPQ 43, 47-48 (CCPA 1963). For obviousness under § 103, all that is required is a reasonable expectation of success. **In re Longi**, 759 F.2d 887, 897, 225 USPQ 645, 651-52 (Fed. Cir. 1985); **In re Clinton**, 527 F.2d 1226, 1228, 188 USPQ 365, 367 (CCPA 1976). The information in the Polisky reference, when combined with the Bahl reference provided such a reasonable expectation of success."

The question before us is, "was there a reasonable expectation of success, or is the disclosure of Want merely an invitation to explore (to try) without any reasonable expectation of success?" We find that the sections of the sections of the Want and Pulley patents cited above, in addition to providing the motivation, also provide one of ordinary skill in the art a reasonable expectation of success. Appellants' statement at page 11, that "an electronic tag and tag reader would probably add to the expense and complexity of the '557 [Pulley] patent," is not persuasive. Expense and complexity are not determinative. What is relevant is "reasonable expectation of success," and we find that it is present.

Therefore, for the reasons above, we will sustain the Examiner's rejection of claims 1, 4, and 6-8 under 35 U.S.C. § 103 as being obvious over the combination of Want and Pulley.

**II. Whether the Rejection of Claims 1, 4, and 6-8 Under
35 U.S.C. § 103 as Being Obvious over Beigel and Card is
proper?**

It is our view, after consideration of the record before us, that the evidence relied upon and the level of skill in the particular art would not have suggested to one of ordinary skill in the art the obviousness of the invention as set forth in claims 1, 4, and 6-8. Accordingly, we reverse.

Appellants have presented the same arguments as noted above with respect to the Want and Pulley references. Here we find Appellants' arguments persuasive. We can find no motivation anywhere in the rejection before us to combine the Beigel and Card references. The Examiner has not met the initial burden of establishing a **prima facie** case of obviousness with respect to the rejection based on these two references.

Therefore, we will not sustain the Examiner's rejection of claims 1, 4, and 6-8 under 35 U.S.C. § 103 as being obvious over the combination of Beigel and Card.

**III. Whether the Rejection of Claim 2 Under 35 U.S.C. § 103
is proper?**

It is our view, after consideration of the record before us, that the evidence relied upon and the level of skill in the particular art would have suggested to one of ordinary skill in the art the obviousness of the invention as set forth in claim 2.

Accordingly, we affirm.

With respect to claim 2 that depends from claim 1, it is rejected over the Want and Pulley references. Appellants argue the patentability of claim 2 by referring to their arguments with respect to claim 1. We have addressed those arguments above. They are not persuasive. Also, Appellants argue, "[t]he Examiner has not pointed to a relevant portion of the '830 [Want] patent suggesting navigation of graphical data." As we noted above with respect to claim 1, Want teaches at lines 32-33 of column 9, "go to a certain location in a document." We find that this suggests navigation of graphical data. Therefore, Appellants argument is not persuasive and we will sustain the Examiner's rejection of claim 2 as being obvious over the combination of Want and Pulley.

IV. Whether the Rejection of Claim 3 Under 35 U.S.C. §103 is proper?

It is our view, after consideration of the record before us, that the evidence relied upon and the level of skill in the particular art would not have suggested to one of ordinary skill in the art the obviousness of the invention as set forth in claim 3. Accordingly, we reverse.

Claim 3 depends from claim 1, and is rejected over the Beigel and Card references. As we have stated above with respect

to claim 1, we can find no motivation anywhere in the rejection before us to combine these references. The Examiner has not met the initial burden of establishing a ***prima facie*** case of obviousness with respect to the rejection of claim 3. Therefore, we will not sustain the Examiner's rejection of claim 3 as being obvious over the combination of Beigel and Card.

***V. Whether the Rejection of Claim 5 Under 35 U.S.C. § 103
Being Obvious over Want and Pulley is proper?***

It is our view, after consideration of the record before us, that the evidence relied upon and the level of skill in the particular art would have suggested to one of ordinary skill in the art the obviousness of the invention as set forth in claim 5. Accordingly, we affirm.

With respect to the rejection of claim 5 over the Want and Pulley references, Appellants argue the patentability of claim 5 by referring to their arguments with respect to claim 1. We have addressed those arguments above. They are not persuasive. Also, Appellants argue, the Examiner "has provided no suggestion or motivation as to why one skilled in the art would wish to combine these references with the details of a credit card." In the final rejection (paper number 10) at page 5, the Examiner takes official notice of credit card surfaces and associated user

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annotations. We do not see that there is any need to rely on the taking of official notice to show the limitations of claim 5.

Claim 5 requires the following limitation," "wherein the electronic tag presents a surface for user defined annotation." We find that the only structure required to meet this claim language is that the tag have "a surface" of sufficient size and shape so that at some future time the user may make an annotation on the surface. Such a surface of sufficient size is taught by Want at line 60 of column 11. Want teaches a tag of "credit card size and shape." We find that this "presents a surface (of sufficient size and shape) for user defined annotation."

Therefore, we will sustain the Examiner's rejection of claim 5 as being obvious over the combination of Want and Pulley.

VI. *Whether the Rejection of Claim 5 Under 35 U.S.C. § 103 as Being Obvious over Beigel and Card is proper?*

It is our view, after consideration of the record before us, that the evidence relied upon and the level of skill in the particular art would not have suggested to one of ordinary skill in the art the obviousness of the invention as set forth in claim 5. Accordingly, we reverse.

As we have stated above with respect to claim 1, we can find no motivation anywhere in the rejection before us to combine the

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Beigel, and Card references. The Examiner has not met the initial burden of establishing a ***prima facie*** case of obviousness with respect to this rejection of claim 5. Therefore, we will not sustain the Examiner's rejection of claim 5 as being obvious over the combination of Beigel and Card.

Other Issues

We note that the Card patent contains a teaching of virtual document data set navigation, and that there is a the possibility that claim 3 should be rejected under 35 U.S.C. § 103 as being obvious over the combination of Want and Pulley and Card, or the combination of Want and Card. We leave it to the Examiner to make this determination at the earliest appropriate point.

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Conclusion

In view of the foregoing discussion, we have sustained the rejection under 35 U.S.C. § 103 of claims 1, 2, and 4-8, and we have not sustained the rejection under 35 U.S.C. § 103 of claim 3.

No time period for taking any subsequent action in connection with this appeal may be extended under 37 CFR § 1.136(a).

AFFIRMED-IN-PART


MICHAEL R. FLEMING

MICHAEL R. FLEMING
Administrative Patent Judge

Joseph F. Ruggiero
JOSEPH F. RUGGIERO

JOSEPH F. RUGGIERO
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